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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/753,591 01/03/01 JURRENS

J JURRENS

EXAMINER

PM82/0606

HUGH D. JAEGER  
SUITE 302  
1000 SUPERIOR BLVD.  
WAYZATA MN 55391-1873

RODRIGUEZ, P  
ART UNIT PAPER NUMBER

3613  
DATE MAILED:

06/06/01 3

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/753,591	JURRENS, JESSE A.
Examiner	Art Unit	
Pam Rodriguez	3613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 January 2001 is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	20) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. Applicant's request for non-publication of this application under 35 U.S.C. 122 (b) (2) (B) (I) has been received but is denied. A request for non-publication of an application must be submitted upon filing of the application to prevent the publication from being printed. Therefore, since applicant's request was filed untimely, the request for non-publication has been denied.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the swing arm with its pairs of arms, wheel mounts, connectors, and upper, lower, and intermediate transverse cross members must all be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

*Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,003,628. This is a double patenting rejection.

All the limitations of Claim 1 of the instant application are recited word for word in Claim 1 of the '628 patent.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jurrens et al.

Regarding Claim 1, Jurrens et al disclose a suspension system 10 for a motorcycle 12 having all the features of the instant invention including: a motorcycle main frame 14, a swing arm 16 pivotally mounted to the motorcycle main frame 14 about a pivot axis 18, and an air bag suspension system 10, wherein the swing arm 16 has a pair of wheel mounts 20 located on a wheel axis 22 spaced to receive the rear

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wheel 24, wherein the swing arm 16 further includes pairs of arms 26 and 28 extending from each of the wheel mounts 20 and connectors 30 connecting each pair of arms 26 and 28 (see Figure 7), wherein each connector 30 is joined to the other connector by an upper transverse cross member 32 and a lower transverse cross member 34, and wherein an intermediate transverse cross member 38 extends along the swing arm pivot axis 18 and through the connectors 30 and is secured to the struts 40 of the motorcycle main frame 14 (see column 4 lines 29-57).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Uhls, Valdespino, Vaillancourt, and Thompson et al all disclose air bag suspensions capable of use on motorcycles.

Thurm and Wiers both disclose motorcycle suspensions having similar main frame and swing arm structures to that of applicant's.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 703-308-3657.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Oberleitner can be reached on 703-308-2569. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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305-7687 for regular communications and 703-305-7687 for After Final  
communications.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is 703-308-  
1113.



PAM RODRIGUEZ  
PATENT EXAMINER

6/2/01

pr

June 2, 2001